

REMARKS/ARGUMENTS

Claims 1-22, 24-26, and 28 remain in this application. Claim 17 has been amended to delete the term “texture” and claims 23 and 27 have been canceled without prejudice, and Applicants reserve the right to pursue such deleted/canceled subject matter and claims in a continuation/divisional application(s). Accordingly, no issues of new matter are believed to be raised by the above amendments to the application.

Rejection Under 35 USC 112, First Paragraph

Claims 17, 19, and 21-28 were rejected under 35 USC 112, first paragraph. See Pages 3-5 of the Office Action. According to the Office Action, “[t]he instant claims are drawn to the methods of regulating the firmness, tone, or texture of skin of a subject or regulating wrinkles in skin of the subject. The instant specification fails to provide information that would allow the skilled artisan to practice the instant invention. See Pages 3-4 of the Office Action. The Applicants respectfully disagree.

As set forth in claim 17, the method “comprises the topical administration to said subject a composition comprising: (a) a safe and effective amount of a Hedychium extract; and (b) a cosmetically-acceptable carrier.” The term topical application is defined on page 2, lines 24-26 of the specification, the term “cosmetically-acceptable” is defined on page 2, lines 27-33, and the term “safe and effective amount” is defined on page 4, lines 1-14 of the specification. The specification also provides various examples of topical compositions and/or carriers, for example, on page 5, line 17 through page 9, line 3. Accordingly, the specification does provide information that would allow the skilled artisan to practice the instant invention. Applicants, therefore, respectfully request that the above rejection under Section 35 USC 112, first paragraph, be withdrawn.

Rejection Under 35 USC 112, Second Paragraph

Claims 17, 19, and 21-28 were rejected under 35 USC 112, second paragraph. See Pages 5-6 of the Office Action. According to the Office Action, “the term ‘safe’ is not defined in the specification and claim.” See Page 6 of the Office Action. Applicants respectfully disagree.

As discussed above, the term “safe and effective amount” is defined on page 4, lines 1-14 of the specification. Applicants, therefore, respectfully request that the above rejection under Section 35 USC 112, second paragraph, be withdrawn.

Rejection Under 35 USC 102

I

Claims 17, 19, and 21-28 were rejected under 35 USC 102(b) as being anticipated by Japanese Patent 61291515 (the “515 Patent”). See Pages 6-7 of the Office Action. According to the Office Action, the ‘515 Patent “discloses a hedychium extract in an effective amount, within the instant claims, is useful in a cosmetic composition with a cosmetically-acceptable carrier for topical administration and a method of treating hot feeling after sunburn, rough skin, razor rash, and inflammations. . . . [The ‘515 Patent]’s method steps inherently treats the skin in a subject for regulating the firmness, tone, or texture of skin of a subject or for regulating wrinkles.” See Page 6 of the Office Action. Applicants respectfully disagree.

In contrast to the ‘515 Patent, as set forth in independent claim 17, the present claimed invention relates to a method of regulating the firmness or tone of skin of a subject or regulating wrinkles in skin of a subject, comprising “the topical administration to said subject a composition comprising: (a) a safe and effective amount of a Hedychium extract; and (b) a cosmetically-acceptable carrier.” As set forth on page 4, lines 1-14 of the specification, “‘safe and effective amount’ means an amount of compound or composition (e.g., the Hedychium extract) sufficient to significantly induce a positive modification in the condition to be regulated or treated. . . .” The compositions of the ‘515 Patent are for treating hot feeling after sunburn, rough skin, razor rash, and inflammations, which are no related to skin firmness, tone, or wrinkles.

As set forth in Section 2112.02 of the M.P.E.P., “The discovery of a new use for an old structure based on unknown properties of the structure might be patentable to the discoverer as a process of using.” The ‘515 Patent does not teach the topical application of a “safe and effective amount” of a composition to regulate the firmness or tone of skin of a subject or regulating wrinkles in skin of a subject. Furthermore, as set forth in *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999), “To establish inherency, the extrinsic evidence

'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.' ... 'Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' The Office Action fails to demonstrate that the compositions of '515 Patent would be applied in a manner that would "necessarily" regulate the firmness or tone of skin of a subject or regulate wrinkles in skin of a subject. The possibility that such compositions may regulate the firmness or tone of skin of a subject or regulate wrinkles in skin of a subject is not sufficient for a rejection under 35 USC 102(b).

Accordingly, Applicants respectfully request the withdrawal of the above rejection under 35 USC 102(b).

II

Claims 17, 19, and 21-28 were rejected under 35 USC 102(b) as being anticipated by Japanese Patent 59181202 (the "202 Patent"). See Page 7 of the Office Action. According to the Office Action, the '202 Patent "discloses that a hedychium extract in an effective amount, within the instant claims, is useful in a topical composition with a cosmetically-acceptable carrier for human skin application for the treatment of insect repelling." See Page 7 of the Office Action. Applicants respectfully disagree.

In contrast to the '202 Patent, as set forth in independent claim 17, the present claimed invention relates to a method of regulating the firmness or tone of skin of a subject or regulating wrinkles in skin of a subject, comprising "the topical administration to said subject a composition comprising: (a) a safe and effective amount of a Hedychium extract; and (b) a cosmetically-acceptable carrier." The compositions of the '202 Patent are for repelling insects.

As discussed above, Section 2112.02 of the M.P.E.P. states, "The discovery of a new use for an old structure based on unknown properties of the structure might be patentable to the discoverer as a process of using." The '202 Patent does not teach the topical application of a "safe and effective amount" of a composition to regulate the firmness or tone of skin of a subject or regulating wrinkles in skin of a subject. Furthermore, as set forth in In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999), "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is

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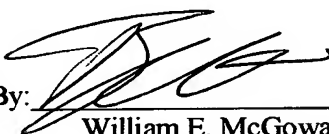
necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.' ... 'Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." The Office Action fails to demonstrate that the compositions of '202 Patent would be applied in a manner that would "necessarily" regulate the firmness or tone of skin of a subject or regulate wrinkles in skin of a subject. As discussed above, the possibility that such compositions may regulate the firmness or tone of skin of a subject or regulate wrinkles in skin of a subject is not sufficient for a rejection under 35 USC 102(b).

Accordingly, Applicants respectfully request the withdrawal of the above rejection under 35 USC 102(b).

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page(s) is/are captioned "Version with markings to show changes made".

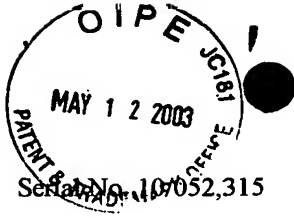
Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Please amend Claim 17 as follows:

17. (Amended) A method of regulating the firmness, or tone, ~~or texture~~ of skin of a subject or regulating wrinkles in skin of a subject, said method comprising the topical administration to said subject a composition comprising:

- (a) a safe and effective amount of a Hedychium extract; and
- (b) a cosmetically-acceptable carrier.

Please cancel claims 23 and 27 without prejudice